



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,637	04/22/2004	Kenneth M. Bednasz	2002-060	7060
54472 7590 05/17/2007 COATS & BENNETT/SONY ERICSSON 1400 CRESCENT GREEN SUITE 300 CARY, NC 27511			EXAMINER CUMMING, WILLIAM D	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 05/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/829,637
Filing Date: January 13, 2004
Appellant(s): KENNETH M. BEDNASZ

MAILED

MAY 17 2007

Technology Center 2600

STEPHEN A. HERRERA (#47,642)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 12, 2007 appealing from the Office action mailed April 6, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Appellant did **NOT** address that claims 17-18 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Willner, et al and Furuta** as applied to claim 16 and 30 above, and further in view of **Ogino et al** (U.S. 6,941,145 B2).

Appellant did **NOT** address that claims 11-13, 24-27, and 42 rejected under 35 U.S.C. 103(a) as being unpatentable over **Willner** and **Furuta** as applied in claims 1, 16, and 30 in view of well known prior art (MPEP 2144.03).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0032434	WILLNER, et al	2-2003
JP2002-176678	FURUTA	6-2002
2004/0033820	LEWIS	2-2004
2002/0086680	HUNZINGER	7-2002
2003/0008661	JOYCE, et al	1-2003
6,941,145	OGINO, et al	9-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- a. Claims 1-9, 14, 16, 19-23, 30-31, 33-34, and 39-41 rejected under 35 U.S.C. §103(a) as being unpatentable over **Willner et al** (U.S. 2003/0032434 A1) in view of **Furuta** (JP2002-176678).

As to claim 1, **Willner** discloses an invention that relates to compliance with location dependent requirements, such as laws and regulations that vary from jurisdiction to jurisdiction (paragraph 1). **Willner** also discloses a compliance system 100 including a requirement controller

400 in communication with a user device 10 (paragraph 25), reading on claimed "*mobile terminal*." **Willner** also discloses a user device 10 may be, for example: a wireless telephone, a portable computing device such as a laptop computer or Personal Digital Assistant (PDA), a vehicle (e.g., an automobile), a one-way or two-way pager, or any other appropriate communication device (paragraph 28), reading on claimed "*a transceiver to transmit signals to and receive signals from a wireless communications network*." It is inherent that a mobile communication device operating in a wireless network would compose a transceiver in order to communicate with the network. **Willner** also discloses the user device 10 receives current location information from a location device 15 and the location device 15 may be, for example, a Global Positioning Satellite (GPS) device that transmits latitude and longitude information to the user device 10 (paragraph 29). **Willner** also discloses the user device 10 determines the location information based on information received from the location device 15 (paragraph 33).

Willner also discloses the location dependent requirement database 500 is stored locally at the user device 10 and the user device 10 may determine location information (e.g., based on information

received from the location device 15) and requirement information without sending any information to the requirement controller 400 (paragraph 77), reading on claimed "determine whether a mobile terminal is proximate a hands-free zone." **Willner** also discloses the user device 10 provides to the user an indication associated with a requirement (e.g., by displaying the requirement to the user) and the requirement is associated with the use or operation of the user device 10 (paragraph 28). **Willner** also discloses an example (paragraph 45): Consider Alice, who is driving while using a wireless telephones in state where this action is permitted. Without realizing it, Alice travels into a neighboring state where it is not permitted unless a *"hands-free"* wireless telephone mode is used, reading on claimed *"a hands-free device to allow the user to place and receive calls in a hands-free only mode."* Based on information received from a remote requirement controller 400, Alice's wireless telephone automatically switches to such a "hands-free" mode, reading on claimed *"indicate to the user whether the mobile terminal is proximate the hands-free zone based on a current location of the mobile terminal."*

Willner also discloses the user's compliance with a requirement [e.g. hands-free requirement] is facilitated by automatically arranging for the user device 10 to operate in accordance with the requirement information (paragraph 42), reading on claimed *"activate the hands-free only mode to permit the user to place and receive calls using the hands-free device while the mobile terminal is proximate the hands-free zone."*

Willner also discloses if the current legal requirement differs from a prior legal requirement (i.e., the legal requirement has changed), the processor 410 transmits an indication of the current legal requirement to the user device 10 (paragraph 54), reading on claimed *"de-activate the hands-free only mode to permit the user to place and receive calls without using the hands-free device while the mobile terminal is proximate the hands-free zone."*

It is inherent for the user device 10 to comprise an controller in order for the mobile phone to operate.

However, **Willner** fails to disclose to determine a velocity of the mobile terminal, activate the hands-free only mode to permit the user to place and receive calls using the hands-free device if the velocity of the mobile terminal is greater than a predetermined threshold, and de\-activate the hands-free only mode to permit the user to place and receive calls without using the hands-free device if the velocity of the mobile terminal is not greater than a predetermined threshold.

The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Furuta**. In the same field of endeavor, **Furuta** teaches a telephone enabled to operate in a hands-free mode automatically when the telephone is in an automobile (paragraph 4).

Furuta also teaches the radio network detects the migration condition of the radio communication equipment (paragraph 5) by using the position sensor prepared in the radio communication equipment (paragraph 8) which detects the rotation of the speed sensor and the wheel which detect the migration condition of a mobile (paragraph 10), reading on claimed "*determine a velocity of the mobile terminal.*" **Furuta** also teaches when the moving speed is equivalent to a moving speed of an automobile and the mobile phone receives an incoming call, the base

station designates the hands-free communication mode to the mobile phone (abstract, paragraph 22), reading on claimed *"activate the hands-free only mode to permit the user to place and receive calls using the hands-free device if the velocity of the mobile terminal is greater than a predetermined threshold."* **Furuta** also teaches when the calculated speed does not exceed the passing speed of an automobile the hands-free flag is set to off (paragraph 22, paraphrased), reading on claimed *"activate the hands-free only mode to permit the user to place and receive calls without using the hands-free device if the velocity of the mobile terminal is not greater than a predetermined threshold."*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the mobile terminal, disclosed by **Willner**, a hands-free device to allow the user to place and receive calls in a hands-free only mode, the controller configured to: activate the hands-free only mode to permit the user to place and receive calls using the hands-free device while the mobile terminal is proximate the hands-free zone, and de-activate the hands-free only mode to permit the user to place and receive calls without using the hands-free device while the mobile terminal is proximate the hands-free zone, also disclosed by **Willner**, activate the hands-free only mode to permit the user to place

and receive calls using the hands-free device if the velocity of the mobile terminal is greater than a predetermined threshold and activate the hands-free only mode to permit the user to place and receive calls without using the hands-free device if the velocity of the mobile terminal is not greater than a predetermined threshold, as taught by **Furuta**, to assist the mobile user in obeying laws forbidding the mobile terminal from operating while driving for safety purposes.

As to claim 2, **Willner** and **Furuta** teach everything as applied in claim 1 and **Willner** also discloses, as stated previously, the user device 10 receives current location information from a location device 15 and the location device 15 may be, for example, a Global Positioning Satellite (GPS) device that transmits latitude and longitude information to the user device 10 (paragraph 29), reading on claimed *"GPS receiver to provide the current location of the mobile terminal."*

As to claim 3, **Willner** and **Furuta** teach everything as applied in claim 1 and **Willner** also discloses the requirement controller 400 determines the location information based on information received from a remote user device 10 (paragraph 34), reading on claimed *"the wireless*

communications network provides the current location of the mobile terminal."

As to claim 4, **Willner** and **Furuta** teach everything as applied in claim 1 and **Willner** also discloses the location information may comprise, for example, latitude and longitude information, map coordinate information, a location type, and/or an indication of a geographic region (e.g., indicating that the user is currently in New York state) (paragraph 33). **Willner** also discloses the requirement controller 400 performs such a translating the latitude and longitude into an indication associated with a jurisdiction (e.g., indicating a particular state, a town, or highway) (paragraph 36), reading on claimed "*the wireless communications network provides coordinates defining the boundary of the hands-free zone.*"

As to claim 5, **Willner** and **Furuta** teach everything as applied in claim 1 and **Willner** also discloses, as stated previously, the location dependent requirement database 500 is stored locally at the user device 10 and the user device 10 may determine location information (e.g., based on information received from the location device 15) and requirement

information without sending any information to the requirement controller 400 (paragraph 77), reading on claimed *"the controller is configured to compare the current location of the mobile terminal to a location indicative of the hands-free zone."*

As to claim 6, **Willner** and **Furuta** teach everything as applied in claim 1 and **Willner** discloses everything as applied in claim 5 and **Willner** also discloses, as stated previously, the location dependent requirement database 500 is stored locally at the user device 10 and the user device 10 may determine location information (e.g., based on information received from the location device 15) and requirement information without sending any information to the requirement controller 400 (paragraph 77), reading on claimed *"comprising memory to store the location indicative of the hands-free zone."* It is inherent that the user device would comprise a memory to store data received from the location device 15.

As to claim 7, **Willner** and **Furuta** teach everything as applied in claim 1 and **Willner** also discloses the user device 10 instead transmits location information to the requirement controller 400 upon a change in a

location type (e.g., when the user enters a new jurisdiction) (paragraph 35). **Willner** also discloses based on an information received from a remote requirement controller 400, [the] wireless telephone automatically switches to such a "hands-free" mode (paragraph 45), reading on claimed *"the controller is configured to activate a hands-free only mode depending on the proximity of the mobile terminal to the hands-free zone."*

As to claim 8, **Willner** and **Furuta** teach everything as applied in claim 1 and **Willner** discloses everything as applied in claim 7 and Willner also discloses the requirement controller 400 may transmit requirement information to the user device 10 facilitate the user's compliance (paragraph 39), reading on claimed *"the controller activates the hands-free only mode responsive to signals received from the wireless communications network."*

As to claim 9, **Willner** and **Furuta** teach everything as applied in claim 1 and **Willner** discloses everything as applied in claim 7 and Willner also discloses the user device 10 instead transmits location information to the requirement controller 400 upon a change in a location (paragraph

35), reading on claimed *"the controller activates the hands-free only mode when the mobile terminal enters the hands-free zone."*

As to claim 16, **Willner** discloses an invention that relates to compliance with location dependent requirements, such as laws and regulations that vary from jurisdiction to jurisdiction (paragraph 1). **Willner** also discloses a compliance system 100, reading on claimed *"wireless communication system,"* including a requirement controller 400, reading on claimed *"mobile site controller,"* in communication with a user device 10 (paragraph 25). **Willner** also discloses the requirement controller 400 and the user device 10 may communicate via a communication network 20, such as a Local Area Network (LAN), a Metropolitan Area Network (MAN), a Wide Area Network (WAN), a proprietary network, a Public Switched Telephone Network (PSTN), a Wireless Application Protocol (WAP) network, a wireless LAN (paragraph 25; Figure 1), reading on claimed *"a base station to communicate within a geographical area identified as being a hands-free zone" and "mobile site controller connected to the base station."* It is inherent that in order for a user device 10 and requirement controller 400 to communicate over the above listed networks via a base station. **Willner** also discloses

the user device 10 receives current location information from a location device 15 and the location device 15 may be, for example, a Global Positioning Satellite (GPS) device that transmits latitude and longitude information to the user device 10 (paragraph 29). **Willner** also discloses the user device 10 determines the location information based on information received from the location device 15 (paragraph 33).

Willner also discloses the location dependent requirement database 500 is stored locally at the user device 10 and the user device 10 may determine location information (e.g., based on information received from the location device 15) and requirement information without sending any information to the requirement controller 400 (paragraph 77). **Willner** also discloses the user device 10 provides to the user an indication associated with a requirement (e.g., by displaying the requirement to the user) and the requirement is associated with the use or operation of the user device 10 (paragraph 28). **Willner** also discloses an example (paragraph 45):

Consider Alice, who is driving while using a wireless telephones in state where this action is permitted. Without realizing it, Alice travels into a neighboring state where it is not permitted unless a *"hands-free"* wireless telephone mode is used. Based on information received from a

remote requirement controller 400, Alice's wireless telephone automatically switches to such a *"hands-free"* mode, reading on claimed *"a mobile terminal to communicate with the base station in a hands-free only mode based on the proximity of the mobile terminal to the hands-free zone."*

However, **Willner** fails to disclose a mobile terminal to communicate with the base station in a hands-free only mode based on a velocity of the mobile terminal. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Furuta**.

Furuta also teaches, as stated previously, the radio network detects the migration condition of the radio communication equipment (paragraph 5) by using the position sensor prepared in the radio communication equipment (paragraph 8) which detects the rotation of the speed sensor and the wheel which detect the migration condition of a mobile (paragraph 10). **Furuta** also teaches, as stated previously, when the moving speed is equivalent to a moving speed of an automobile and the mobile phone receives an incoming call, the base station designates the hands-free communication mode to the mobile phone (abstract, paragraph 22), reading on claimed *"a mobile terminal to communicate*

with the base station in a hands-free only mode based on a velocity of the mobile terminal."

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the mobile terminal, disclosed by **Willner**, a mobile terminal to communicate with the base station in a hands-free only mode based on a velocity of the mobile terminal, as taught by **Furuta**, to assist the mobile user in obeying laws forbidding the mobile terminal from operating while driving for safety purposes.

As to claim 19, **Willner** and **Furuta** teach everything as applied in claim 16 above and **Willner** also discloses the user device 10 receives current location information from a location device 15 and the location device 15 may be, for example, a Global Positioning Satellite (GPS) device that transmits latitude and longitude information to the user device 10 (paragraph 29), reading on claimed "*the mobile terminal comprises a GPS receiver to provide a current location of the mobile terminal.*"

As to claim 20, **Willner** and **Furuta** teach everything as applied in claim 16 above and **Willner** also discloses, as stated previously (paragraph 45):

Consider Alice, who is driving while using a wireless telephones in state where this action is permitted. Without realizing it, Alice travels into a neighboring state where it is not permitted unless a "*hands-free*" wireless telephone mode is used. Based on information received from a remote requirement controller 400, Alice's wireless telephone automatically switches to such a "*hands-free*" mode.

Willner also discloses the location dependent requirement database 500 is stored locally at the user device 10 and the user device 10 may determine location information (e.g., based on information received from the location device 15) and requirement information without sending any information to the requirement controller 400 (paragraph 77), reading on claimed "*the mobile terminal comprises a controller configured to activate the hands-free only mode in the mobile terminal based upon the proximity of the mobile terminal to the hands-free zone while proximate the hands-free zone.*"

However, **Willner** fails to disclose and based on whether the velocity of the mobile terminal exceeds a predetermined threshold. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Furuta**.

Furuta also teaches, as stated previously, when the moving speed is equivalent to a moving speed of an automobile and the mobile phone receives an incoming call, the base station designates the hands-free communication mode to the mobile phone (abstract, paragraph 22), reading on claimed *"based on whether the velocity of the mobile terminal exceeds a predetermined threshold."*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the mobile terminal, disclosed by **Willner**, a mobile terminal to communicate with the base station in a hands-free only mode based on a velocity of the mobile terminal, as taught by **Furuta**, the mobile terminal comprises a controller configured to activate the hands-free only mode in the mobile terminal based upon the proximity of the mobile terminal to the hands-free zone while proximate the hands-free zone, also disclosed by **Willner**, based on

whether the velocity of the mobile terminal exceeds a predetermined threshold, also taught by **Furuta**, to assist the mobile user in obeying laws forbidding the mobile terminal from operating while driving for safety purposes.

As to claim 21, **Willner** and **Furuta** teach everything as applied in claims 16 and 20 and **Willner** also discloses the location dependent requirement database 500 is stored locally at the user device 10 and the user device 10 may determine location information (e.g., based on information received from the location device 15) and requirement information without sending any information to the requirement controller 400 (paragraph 77), reading on claimed "*the controller compares the current location of the mobile terminal to a location indicative of the hands-free zone.*"

As to claim 22, **Willner** and **Furuta** teach everything as applied in claims 16 and 20 and **Willner** also discloses the user device 10 transmits the location information to the requirement controller 400 in association with a requirement request (paragraph 35). **Willner** also discloses (paragraph 45):

Consider Alice, who is driving while using a wireless telephones in state where this action is permitted. Without realizing it, Alice travels into a neighboring state where it is not permitted unless a *"hands-free"* wireless telephone mode is used. Based on information received from a remote requirement controller 400, Alice's wireless telephone automatically switches to such a *"hands-free"* mode, reading on claimed *"the controller activates the hands-free only mode responsive to signals received from the base station."*

As to claim 23, **Willner** and **Furuta** teach everything as applied in claims 16 and 20 and **Willner** also discloses the user device 10 instead transmits location information to the requirement controller 400 upon a change in a location type (paragraph 35), reading on claimed *"the controller activates the hands-free only mode when the mobile terminal enters the hands-free zone."*

As to claim 30, **Willner** discloses an invention that relates to compliance with location dependent requirements, such as laws and regulations that vary from jurisdiction to jurisdiction (paragraph 1). **Willner** also discloses a compliance system 100 including a requirement controller

400 in communication with a user device 10 (paragraph 25), reading on claimed "*a method of controlling a mobile terminal operating in a wireless communications network.*" **Willner** also discloses a user device 10 may be, for example: a wireless telephone, a portable computing device such as a laptop computer or Personal Digital Assistant (PDA), a vehicle (e.g., an automobile), a one-way or two-way pager, or any other appropriate communication device (paragraph 28). **Willner** also discloses the user device 10 receives current location information from a location device 15 and the location device 15 may be, for example, a Global Positioning Satellite (GPS) device that transmits latitude and longitude information to the user device 10 (paragraph 29). **Willner** also discloses the user device 10 determines the location information based on information received from the location device 15 (paragraph 33), reading on claimed "*determining a current location of a mobile terminal.*" **Willner** also discloses the location dependent requirement database 500 is stored locally at the user device 10 and the user device 10 may determine location information (e.g., based on information received from the location device 15) and requirement information without sending any information to the requirement controller 400 (paragraph 77). **Willner** also discloses the user device 10 provides to the user an indication

associated with a requirement (e.g., by displaying the requirement to the user) and the requirement is associated with the use or operation of the user device 10 (paragraph 28). **Willner** also discloses an example (paragraph 45):

Consider Alice, who is driving while using a wireless telephones in state where this action is permitted. Without realizing it, Alice travels into a neighboring state where it is not permitted unless a "*hands-free*" wireless telephone mode is used. Based on information received from a remote requirement controller 400, Alice's wireless telephone automatically switches to such a "*hands-free*" mode, reading on claimed "*indicating to a user whether the mobile terminal is proximate a hands-free zone based on the current location of the mobile terminal and a location indicative of the hands-free zone.*"

Willner also discloses the user's compliance with a requirement [e.g. hands-free requirement] is facilitated by automatically arranging for the user device 10 to operate in accordance with the requirement information (paragraph 42), reading on claimed "*activate the hands-free only mode to permit the user to place and receive calls using the hands-free device while the mobile terminal is proximate the hands-free zone.*"

Willner also discloses if the current legal requirement differs from a prior legal requirement (i.e., the legal requirement has changed), the processor 410 transmits an indication of the current legal requirement to the user device 10 (paragraph 54), reading on claimed "*de-activate the hands-free only mode to permit the user to place and receive calls without using the hands-free device while the mobile terminal is proximate the hands-free zone.*"

However, **Willner** fails to disclose to determining a velocity of the mobile terminal, activating the hands-free only mode to permit the user to place and receive calls using the hands-free device if the velocity of the mobile terminal is greater than a predetermined threshold, and de-activating the hands-free only mode to permit the user to place and receive calls without using the hands-free device if the velocity of the mobile terminal is not greater than a predetermined threshold. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Furuta**.

Furuta also teaches the radio network detects the migration condition of the radio communication equipment (paragraph 5) by using the position sensor prepared in the radio communication equipment (paragraph 8) which detects the rotation of the speed sensor and the wheel which detect the migration condition of a mobile (paragraph 10), reading on claimed *"determine a velocity of the mobile terminal."* **Furuta** also teaches when the moving speed is equivalent to a moving speed of an automobile and the mobile phone receives an incoming call, the base station designates the hands-free communication mode to the mobile phone (abstract, paragraph 22), reading on claimed *"activate the hands-free only mode to permit the user to place and receive calls using the hands-free device if the velocity of the mobile terminal is greater than a predetermined threshold."* **Furuta** also teaches when the calculated speed does not exceed the passing speed of an automobile the hands-free flag is set to off (paragraph 22, paraphrased), reading on claimed *"activate the hands-free only mode to permit the user to place and receive calls without using the hands-free device if the velocity of the mobile terminal is not greater than a predetermined threshold."*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the method, discloses by **Willner**, the steps of determining a velocity of the mobile terminal, activating the hands-free only mode to permit the user to place and receive calls using the hands-free device if the velocity of the mobile terminal is greater than a predetermined threshold, and de-activating the hands-free only mode to permit the user to place and receive calls without using the hands-free device if the velocity of the mobile terminal is not greater than a predetermined threshold, as taught by **Furuta**, to assist the mobile user in obeying laws forbidding the mobile terminal from operating while driving for safety purposes.

As to claim 31, **Willner** and **Furuta** teach everything as applied in claim 30 and **Willner** also discloses the user device 10 receives current location information from a location device 15 and the location device 15 may be, for example, a Global Positioning Satellite (GPS) device that transmits latitude and longitude information to the user device 10 (paragraph 29), reading on claimed *"the mobile terminal computes the current location responsive to location signals received over a GPS receiver."*

As to claim 33, **Willner** and **Furuta** teach everything as applied in claim 30 and **Willner** also discloses the user device 10 receives current location information from a location device 15 and the location device 15 may be, for example, a Global Positioning Satellite (GPS) device that transmits latitude and longitude information to the user device 10 (paragraph 29). **Willner** also discloses the location information may comprise, for example, latitude and longitude information, map coordinate information (e.g., "C3"), a location type (e.g., indicating that the user is currently on an interstate highway), and/or an indication of a geographic region (e.g., indicating that the user is currently in New York state) (paragraph 33), reading on claimed "*determining the proximity of the current location of the mobile terminal to the location indicative of the hands-free zone.*"

As to claim.34, **Willner** and **Furuta** teach everything as applied in claims 30 and **Willner** discloses everything as applied in claim 33 and **Willner** also discloses the requirement controller 400 determines the requirement information by retrieving pre-stored information from a database based on the location information (paragraph 38), reading on

claimed *"comparing the current location of the mobile terminal to the location indicative of the hands-free zone."*

As to claim 39, **Willner** and **Furuta** teach everything as applied in claim 30 and **Willner** also discloses (paragraph 45):

Consider Alice, who is driving while using wireless telephones in state where this action is permitted. Without realizing it, Alice travels into a neighboring state where it is not permitted unless a *"hands-free"* wireless telephone mode is used. Based on information received from a remote requirement controller 400, Alice's wireless telephone automatically switches to such a *"hands-free"* mode, reading on claimed *"indicating the proximity of the mobile terminal to the hands-free zone comprises displaying a text message over a display of the mobile terminal."*

As to claim 40, **Willner** and **Furuta** teach everything as applied in claim 30 and **Willner** also discloses (paragraph 45):

Consider Alice, who is driving while using wireless telephones in state where this action is permitted. Without realizing it, Alice travels into a neighboring state where it is not permitted unless a *"hands-free"*

wireless telephone mode is used. Based on information received from a remote requirement controller 400, Alice's wireless telephone automatically switches to such a *"hands-free"* mode, reading on claimed *"indicating the proximity of the mobile terminal to the hands-free zone comprises activating a visual indicator on the mobile terminal."*

As to claim 41, **Willner** and **Furuta** teach everything as applied in claim 30 and **Willner** also discloses the user device 10 instead transmits location information to the requirement controller 400 upon a change in a location type (paragraph 35). **Willner** also discloses (paragraph 45): Consider Alice, who is driving while using wireless telephones in state where this action is permitted, without realizing it, Alice travels into a neighboring state where it is not permitted unless a *"hands-free"* wireless telephone mode is used. Based on information received from a remote requirement controller 400, Alice's wireless telephone automatically switches to such a *"hands-free"* mode, reading on claimed *"activating the hands-free only mode when the mobile terminal enters the hands-free zone."*

b. Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Willner, et al** and **Furuta** as applied to claim 1 above, and further in view of **Lewis** (U.S. 2004/0033820 A1).

As to claim 10, **Willner** and **Furuta** teach everything as applied in claim 1, however, neither **Willner** nor **Furuta** teach the controller enables the hands-free only mode when a user of mobile terminal places or receives a call. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Lewis**.

In the same field of endeavor, **Lewis** teaches a hands-free kit for a mobile radiotelephone handset (paragraph 1). **Lewis** also teaches the earpiece is arranged to operate for periods in a standby mode, wherein one or more functions of the earpiece are disabled to conserve power, the earpiece preferably being arranged to enter the standby mode in the absence of a received signal or if a valid identification signal is not received; the or each disabled function is preferably restored in response to a received signal, preferably only if that signal comprises a valid identification signal (paragraph 39). **Lewis** also teaches the transmitter is preferably arranged to operate for periods in a standby

mode, wherein one or more functions of the transmitter are disabled to conserve power, in the absence of an audio signal from the handset (paragraph 42). **Lewis** also teaches the transmitter unit 6 is arranged to periodically retransmit the identity code within an audio stream, the earpiece 4 being arranged entering a standby mode, to conserve power, in the absence of a received signal or where a valid identity code is not received within a period of time (paragraph 75), reading on claimed *"the controller activates the hands-free only mode when a user of mobile terminal places or receives a call."*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the mobile terminal and controller, taught by **Willner** and **Furuta**, the controller enables the hands-free only mode when a user of mobile terminal places or receives a call, to reduce the power consumption of the wireless transmitter in the mobile device.

As to claim 15, **Willner** and **Furuta** teach everything as applied in claim 1, however, neither **Willner** nor **Furuta** teach the hands-free device comprises a hands-free headset. The Examiner contends this feature

was old and well known in the art at the time of invention as taught by **Lewis**.

Lewis teaches a hands-free kit for a mobile radiotelephone handset (paragraph 1). **Lewis** also teaches the transmitter unit 6 also comprises a microphone, with audio signals being transmitted from the handset to the infra-red transmitter of the unit and from the microphone to the handset, via either a wired or a wireless link, so that the handset may be located a safe distance from the user's head (paragraph 72), reading on claimed "*the hands-free device comprises a hands- free headset.*"

Therefore, it would have been very obvious to one of ordinary skill in the art at the time of invention to require the mobile terminal, taught by **Willner** and **Furuta**, the hands-free device comprises a hands-free headset, as taught by **Lewis**, to enable the mobile user to easily operate in a hands-free manner.

c. Claims 17-18 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Willner** and **Furuta** as applied to claim 16 and 30 above, and further in view of **Ogino et al** (U.S. 6,941,145 B2).

As to claim 17, **Willner** and **Furuta** everything as applied in claim 16; however, neither **Willner** nor **Furuta** teach a location server connected to the base station to provide a current location of the mobile terminal. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Ogino**.

In the same field of endeavor, **Ogino** teaches an invention is related to a radio communication terminal arranged in such a manner that both retrieval timing and retrieval time, which are required to retrieve for GPS satellites, are received via a communication base station from a position information server (column 1, lines 13-17). **Ogino** also teaches the mobile phone 1 transmits the GPS satellite information and the nearby base station information to the position information server 4 (column 14, lines 21-24). **Ogino** also teaches the position information server 4 receives both the GPS satellite information and the nearby base station information from the mobile phone 1, the position information server 4 executes the positioning calculation based upon the received GPS satellite information and the received nearby base station information (column 14, lines 25-30), reading on claimed "*a location server*

connected to the base station to provide a current location of the mobile terminal."

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the wireless communication system and base station, taught by **Willner** and **Furuta**, a location server connected to the base station to provide a current location of the mobile terminal, as taught by **Ogino**, to enable the wireless communication system to determine the location of the mobile device when the location determination capabilities of the mobile device fail.

As to claim 18, **Willner** and **Furuta** teach everything as applied in claim 16 and **Ogino** teaches everything as applied in claim 17, however, neither **Willner** nor **Furuta** teach the location server further provides a location of the hands-free zone to the mobile terminal. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Ogino**.

Ogino also teaches the position information server 4 transmits a positioning result indicative of this specified present position to the mobile phone 1 and when the mobile phone 1 receives the positioning result from the position information server 4, the mobile phone 1 displays this received positioning result on the display unit 13 (column 14, lines 31-36), reading on claimed "*the location server further provides a location of the hands-free zone to the mobile terminal.*"

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the wireless communication system and base station, taught by **Willner** and **Furuta**, a location server connected to the base station to provide a current location of the mobile terminal, as taught by **Ogino**, the location server further provides a location of the hands-free zone to the mobile terminal, also taught by **Ogino**, to enable the wireless communication system to determine the location of the mobile device when the location determination capabilities of the mobile device fail.

As to claim 32, **Willner** and **Furuta** teach everything as applied in claim 30, however, neither **Willner** nor **Furuta** teach the mobile terminal receiving the current location from a base station in the wireless communications network. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Ogino**.

Ogino also teaches the position information server 4 transmits a positioning result indicative of this specified present position to the mobile phone 1 and when the mobile phone 1 receives the positioning result from the position information server 4, the mobile phone 1 displays this received positioning result on the display unit 13 (column 14, lines 31-36), reading on claimed *"the mobile terminal receiving the current location from a base station in the wireless communications network."*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the method, taught by **Willner** and **Furuta**, the step of the mobile terminal receiving the current location from a base station in the wireless communications network, as taught by **Ogino**, to enable the wireless communication system to determine

the location of the mobile device when the location determination capabilities of the mobile device fail.

d. Claims 28-29, 35, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Willner** and **Furuta** as applied to claims 16 and 30 above, and further in view of **Hunzinger** (U.S. 2002/0086680 A1).

As to claim 28, **Willner** and **Furuta** teach everything as applied in claim 16, however, neither **Willner** nor **Furuta** teach the controller enables the hands-free only mode when the mobile terminal registers with the base station. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Hunzinger**.

In the same field of endeavor, **Hunzinger** teaches a system that allows wireless communication system mobile terminal users to set reminders or actions in general to occur or be triggered based on a wireless terminals location or location dynamics (paragraph 2). **Hunzinger** also teaches the terminal also stores the location reminder trigger and action information and a reference to the current location 220 (paragraph 24). **Hunzinger** also teaches the terminal monitors the current location

information and detects when the terminal has handed-off to another base-station or has exceeded a pre-set distance from the stored location (paragraph 24). It is inherent that when a mobile station hands-off to another base station, it must register with the base station being transferred to. **Hunzinger** also teaches the mobile may detect that it is has transitioned out of the area described by the stored location information or that the current location matches the stored location information 230 but the direction of travel may also be checked 235 (paragraph 24), reading on claimed *"the controller activates the hands-free only mode when the mobile terminal registers with the base station."*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the wireless communication system and controller, taught by **Willner** and **Furuta**, the controller enables the hands-free only mode when the mobile terminal registers with the base station, as taught by **Hunzinger**, to enable the wireless communication system to take particular actions based on the location of the wireless device within the system.

As to claim 29, **Willner** discloses everything as applied in claim 16; however, **Willner** neither **Willner** nor **Furuta** teach the controller enables the hands-free only mode upon hand-off of the mobile terminal to the base station. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Hunzinger**. **Hunzinger** also teaches, as stated previously, the terminal monitors the current location information and detects when the terminal has handed-off to another base-station or has exceeded a pre-set distance from the stored location (paragraph 24). **Hunzinger** also teaches the mobile may detect that it is has transitioned out of the area described by the stored location information or that the current location matches the stored location information 230 but the direction of travel may also be checked 235 (paragraph 24), reading on claimed "*the controller enables the hands-free only mode upon hand-off of the mobile terminal to the base station.*"

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the wireless communication system and controller, taught by Willner and Furuta, the controller enables the hands-free only mode upon hand-off of the mobile terminal to the base

station, as taught by **Hunzinger**, to enable the wireless communication system to take particular actions based on the location of the wireless device within the system.

As to claim 35 **Willner** and **Furuta** teach everything as applied in claim 30, however, neither **Willner** nor **Furuta** teach determining a distance of the mobile terminal from the location indicative of the hands-free zone, and indicating whether the mobile terminal is proximate the hands-free zone based on the distance. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Hunzinger**.

Hunzinger also teaches, as stated previously, the terminal monitors the current location information and detects when the terminal has handed-off to another base-station or has exceeded a pre-set distance from the stored location (paragraph 24). **Hunzinger** also teaches the mobile may detect that it is has transitioned out of the area described by the stored location information or that the current location matches the stored location information 230 but the direction of travel may also be checked 235 (paragraph 24). **Hunzinger** also teaches the transition may be

based on proximity, distance, time, time delay, signal conditions, environment, user actions, current network parameters (base station ID, pilot, system, network ID, etc) or other location or time based method (paragraph 35), reading on claimed *"determining a distance of the mobile terminal from the location indicative of the hands-free zone, and indicating whether the mobile terminal is proximate the hands-free zone based on the distance."*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the method, taught by **Willner** and **Furuta**, the step of determining a distance of the mobile terminal from the location indicative of the hands-free zone, and indicating whether the mobile terminal is proximate the hands-free zone based on the distance, as taught by **Hunzinger**, to enable the wireless communication system to take particular actions based on the location of the wireless device within the system.

As to claim 38, **Willner** and **Furuta** teach everything as applied in claim 30; however, neither **Willner** nor **Furuta** teach indicating the proximity of the mobile terminal to the hands-free zone comprises

rendering an audible sound over a speaker of the mobile terminal. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Hunzinger**.

Hunzinger also teaches the user may select from one or more options of actions to be executed when the reminder is triggered; examples of options include but are not limited to setting or selecting a text message, setting, recording or selecting a voice memo or voice message recording, setting or selecting a ringer, or selecting a number to be dialed or called (paragraph 30), reading on claimed *"indicating the proximity of the mobile terminal to the hands-free zone comprises rendering an audible sound over a speaker of the mobile terminal."*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the method, taught by **Willner** and **Furuta**, the step of indicating the proximity of the mobile terminal to the hands-free zone comprises rendering an audible sound over a speaker of the mobile terminal, as taught by **Hunzinger**, to enable the wireless communication system to take particular actions based on the location of the wireless device within the system.

e. Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Willner** and **Furuta** as applied to claim 30 above, and further in view of **Joyce et al** (U.S. 2003/008661 A1).

As to claim 36, **Willner** and **Furuta** everything as applied in claim 30, however, neither **Willner** nor **Furuta** teach determining a direction of travel of the mobile terminal, and indicating whether the mobile terminal is proximate the hands-free zone based on the direction of travel.

The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Joyce**. In the same field of endeavor, **Joyce** teaches an invention relates to delivering content to a mobile terminal, and in particular, to delivering content based on a relative location between the mobile terminal and a location for the content provider (paragraph 1). **Joyce** also teaches the polling algorithm for the daemon would essentially identify location-based information for the mobile terminal 16 and trigger content according to any number of scenarios and the polling algorithm could also detect direction and relative or current velocity to help determine when and if to

provide content (paragraph 50), reading on claimed "*determining a direction of travel of the mobile terminal, and indicating whether the mobile terminal is proximate the hands-free zone based on the direction of travel.*"

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the method, taught by **Willner** and **Furuta**, the step of determining a direction of travel of the mobile terminal, and indicating whether the mobile terminal is proximate the hands-free zone based on the direction of travel, as taught by **Joyce**, to provide the mobile user information based on the proximity of the user to a particular location or zone.

As to claim 37, **Willner** and **Furuta** teach everything as applied in claim 30; however, neither **Willner** nor **Furuta** teach determining a velocity of the mobile terminal, and indicating whether the mobile terminal is proximate the hands-free zone based on the velocity. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Joyce**.

Joyce also teaches the polling algorithm for the daemon would essentially identify location-based information for the mobile terminal 16 and trigger content according to any number of scenarios and the polling algorithm could also detect direction and relative or current velocity to help determine when and if to provide content (paragraph 50), reading on claimed *"determining a velocity of the mobile terminal, and indicating whether the mobile terminal is proximate the hands-free zone based on the velocity."*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the method, taught by **Willner** and **Furuta**, the step of determining a velocity of the mobile terminal, and indicating whether the mobile terminal is proximate the hands-free zone based on the velocity, as taught by **Joyce**, to provide the mobile user information based on the proximity of the user to a particular location or zone.

- f. Claims 11-13, 24-27, and 42 rejected under 35 U.S.C. 103(a) as being unpatentable over **Willner** and **Furuta** as applied in claims 1, 16, and 30 in view of well known prior art (MPEP 2144.03).

As to claim 11, **Willner** and **Furuta** teach everything as applied in claim 1 and **Willner** further discloses the user device 10 instead transmits location information to the requirement controller 400 upon a change in a location type (e.g., when the user enters a new jurisdiction) (paragraph 35). **Willner** also discloses based on an information received from a remote requirement controller 400, [the] wireless telephone automatically switches to such a "*hands-free*" mode (paragraph 45).

However, **Willner** and **Furuta** fails to specifically teach the controller is configured to deactivate a hands-free only mode depending on the proximity of the mobile terminal to the hands- free zone. The Examiner contends this feature was old and well known in the art at the time of invention as taught by well-known prior art.

The Examiner takes Official Notice that it would have been obvious and well known in the art at the time of invention to desist requiring a mobile device operate in a hands-free mode if a mobile device leaves the area in which the hands-free mode was required. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the mobile terminal and controller, taught by **Willner** and **Furuta**, the controller is configured to deactivate a hands-free only mode depending on the proximity of the mobile terminal to the hands-free zone, as taught by well known prior art, to enable a mobile device to return to normal operations when restricted operations are not required.

As to claim 12, **Willner** and **Furuta** teach everything as applied in claim 1 and well known prior art teach everything as applied in claim 11 and **Willner** also discloses the requirement controller 400 may transmit requirement information to the user device 10 facilitate the user's compliance (paragraph 39), reading on claimed *"the controller deactivates the hands-free only mode responsive to signals received from the wireless communications network."*

As to claim 13, **Willner** and **Furuta** everything as applied in claim 1 and well known prior art teaches everything as applied in claim 11 and **Willner** also discloses the user device 10 instead transmits location information to the requirement controller 400 upon a change in a location (paragraph 35).

However, **Willner** and **Furuta** fail to specifically teach the controller deactivates the hands-free only mode when the mobile terminal leaves the hands-free zone. The Examiner contends this feature was old and well known in the art at the time of invention as taught by well-known prior art.

The Examiner takes Official Notice that it would have been obvious and well known in the art at the time of invention for a mobile device to desist operating in a hands-free mode if a mobile device leaves the area in which the hands-free mode was required. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the mobile terminal and controller, taught by **Willner** and **Furuta**, the controller is configured to deactivate a hands-free only mode depending on the proximity of the mobile terminal to the

hands- free zone, as taught by well known prior art, the controller deactivates the hands-free only mode when the mobile terminal leaves the hands-free zone, also taught by well known prior art, to enable a mobile device to return to normal operations when restricted operations are not required.

As to claim 24 **Willner** and **Furuta** teach everything as applied in claim 16 and **Willner** further discloses the user device 10 instead transmits location information to the requirement controller 400 upon a change in a location type (e.g., when the user enters a new jurisdiction) (paragraph 35). **Willner** also discloses based on an information received from a remote requirement controller 400, [the] wireless telephone automatically switches to such a "*hands-free*" mode (paragraph 45).

However, **Willner** and **Furuta** fail to specifically teach the mobile terminal comprises a controller configured to deactivate the hands-free only mode in the mobile terminal based upon the proximity of the mobile terminal to the hands-free zone. The Examiner contends this feature was old and well known in the art at the time of invention as taught by

well-known prior art. The Examiner takes Official Notice that it would have been obvious and well known in the art at the time of invention to desist requiring a mobile device operate in a hands-free mode if a mobile device leaves the area in which the hands-free mode was required.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the system and controller, disclosed by **Willner**, the mobile terminal comprises a controller configured to deactivate the hands-free only mode in the mobile terminal depending upon the proximity of the mobile terminal to the hands-free zone while proximate the hands-free zone, as taught by well known prior art, to enable a mobile device to return to normal operations when restricted operations are not required.

However, **Willner** and well known prior art fail to teach deactivating the hands-free only mode based on whether the velocity of the mobile terminal exceeds a predetermined threshold. The Examiner contends this feature was old and well known in the art at the time of invention as taught by **Furuta**.

Furuta also teaches, as stated previously, when the calculated speed does not exceed the passing speed of an automobile the hands-free flag is set to off (paragraph 22, paraphrased), reading on claimed *"deactivating the hands-free only mode based on whether the velocity of the mobile terminal exceeds a predetermined threshold."*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the system and controller, disclosed by **Willner**, the mobile terminal comprises a controller configured to deactivate the hands-free only mode in the mobile terminal depending upon the proximity of the mobile terminal to the hands-free zone while proximate the hands-free zone, as taught by well known prior art, as taught by **Furuta**, to assist the mobile user in obeying laws forbidding the mobile terminal from operating while driving for safety purposes.

As to claim 25 **Willner** and **Furuta** everything as applied in claim 16 and well known prior art and **Furuta** teach everything as applied in claim 24 and **Willner** also discloses the location dependent requirement database 500 is stored locally at the user device 10 and the user device 10 may determine location information (e.g., based on information

received from the location device 15) and requirement information without sending any information to the requirement controller 400 (paragraph 77), reading on claimed *"the controller compares the current location of the mobile terminal to a location indicative of the hands-free zone."*

As to claim 26, **Willner** and **Furuta** everything as applied in claim 16 and well known prior art and **Furuta** teach everything as applied in claim 24 and **Willner** also discloses the requirement controller 400 may transmit requirement information to the user device 10 facilitate the user's compliance (paragraph 39), reading on claimed *"the controller disables the hands-free only mode responsive to signals received from the base station."*

As to claim 27, **Willner** and **Furuta** everything as applied in claim 16 and well known prior art and **Furuta** teach everything as applied in claim 24 and **Willner** also discloses the user device 10 instead transmits location information to the requirement controller 400 upon a change in a location (paragraph 35).

However, **Willner** fails to specifically disclose the controller disables the hands-free only mode when the mobile terminal leaves the hands-free zone. The Examiner contends this feature was old and well known in the art at the time of invention as taught by well-known prior art.

The Examiner takes Official Notice that it would have been obvious and well known in the art at the time of invention for a mobile device to desist operating in a hands-free mode if a mobile device leaves the area in which the hands-free mode was required.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the system and controller, taught by **Willner** and **Furuta**, the mobile terminal comprises a controller configured to disable the hands-free only mode in the mobile terminal depending upon the proximity of the mobile terminal to the hands-free zone and based on whether the velocity of the mobile terminal exceeds a predetermined threshold, as taught by well known prior art and **Furuta**, the controller disables the hands-free only mode when the mobile terminal leaves the hands-free zone, also taught by well known prior art, to enable a mobile device to return to normal operations when

restricted operations are not required.

As to claim 42, **Willner** and **Furuta** everything as applied in claims 30 and 41 and **Willner** also discloses the user device 10 instead transmits location information to the requirement controller 400 upon a change in a location (paragraph 35).

However, **Willner** fails to specifically disclose deactivating the hands-free only mode when the mobile terminal leaves the hands-free zone. The Examiner contends this feature was old and well known in the art at the time of invention as taught by well-known prior art. The Examiner takes Official Notice that it would have been obvious and well known in the art at the time of invention for a mobile device to desist operating in a hands-free mode if a mobile device leaves the area in which the hands-free mode was required.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to require the method, taught by **Willner** and **Furuta**, the step of deactivating the hands-free only mode when the mobile terminal leaves the hands-free zone, also taught by well known

prior art, to enable a mobile device to return to normal operations when restricted operations are not required.

(10) Response to Argument

In response to appellant's arguments against the references individually, that **Willner, et al** does not disclose velocity and **Furuta** does not disclose location, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner have shown that the references do meet all the claimed limitations and the Appellant does not dispute since he admits that **Willner, et al** disclose the location limitation and **Furuta** teaches velocity limitation since he is arguing the references as if the references are in total isolation from each other.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves OR in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill

in the art at the time of invention to require the mobile terminal, disclosed by **Willner**, a mobile terminal to communicate with the base station in a hands-free only mode based on a velocity of the mobile terminal, as taught by **Furuta**, the mobile terminal comprises a controller configured to activate the hands-free only mode in the mobile terminal based upon the proximity of the mobile terminal to the hands-free zone while proximate the hands-free zone, also disclosed by **Willner**, based on whether the velocity of the mobile terminal exceeds a predetermined threshold, also taught by **Furuta**, to assist the mobile user in obeying laws forbidding the mobile terminal from operating while driving for safety purposes.

The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The Court has held that a "*patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.*" *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 152 (1950); *KSR INTERNATIONAL CO. v. TELEFLEX INC.* et al. on writ of certiorari to the United States Court of Appeals for the Federal Circuit [April 30, 2007]

Regarding Appellant's argument that the references must teach the motivation, the obviousness analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, the Examiner can take account of the inferences and creative steps that a person of ordinary skill in the art would employ. The obviousness analysis **cannot** be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining **previously known elements**, deprive prior inventions of their value or utility. One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the claims. When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to

try might show that it was obvious under 35 USC §103. *KSR INTERNATIONAL CO. v. TELEFLEX INC.* et al. on writ of certiorari to the United States Court of Appeals for the Federal Circuit [April 30, 2007]

The Examiner has showed motivation that a person of ordinary skill had good reason to pursue the known options within his or her technical grasp and showed anticipated success. A motivation, to assist the mobile user in obeying laws forbidding the mobile terminal from operating while driving for safety purposes, which would be recognized by one ordinary skilled in the art, a known problem for which there was an obvious solution, and also even suggested by the **Furuta** reference.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



WILLIAM D. CUMMING

Primary Examiner of Art Unit 2617

Conferees:



CHARLES N. APPIAH
SUPERVISORY PATENT EXAMINER



NICK CORSARO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600